

**REMARKS**

In the Office Action<sup>1</sup>, the Examiner:

objected to claims 1, 5, 8, 9, 16, 17, 24, 25, and 27 for alleged informalities;

rejected claims 1-5, 7-13, 15-21, 23-25, 27 and 28 under 35 U.S.C. § 112, second paragraph, as allegedly indefinite;

rejected claims 1-5, 9-13, and 17-21 under 35 U.S.C. § 103(a) as allegedly obvious over U.S. Patent Publication No. 2002/0059127 to Brown et al. ("Brown") in view of U.S. Patent No. 7,016,870 to Jones et al. ("Jones");

rejected claims 7, 8, 15, 16, and 23-25 under 35 U.S.C. § 103(a) as allegedly obvious over Brown and Jones in view of U.S. Patent Publication No. 2005/0262014 to Fickes ("Fickes");

rejected claim 27 under 35 U.S.C. § 103(a) as allegedly obvious over Brown, Jones, and Fickes in view of U.S. Patent Publication No. 2004/0158479 to Adhikari ("Adhikari"); and

rejected claim 28 under 35 U.S.C. § 103(a) as allegedly obvious over Brown, Jones, Fickes and Adhikari, in view of U.S. Patent Publication No. 2002/0019810 to Kumar et al. ("Kumar").

Claims 1-5, 7-13, 15-21, 23-25, 27, and 28 are pending in this application.

Claims 1, 9, 17, 25, and 27 are amended by this reply. No new matter is added by this Amendment.

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<sup>1</sup> The Office Action may contain statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

Applicant respectfully traverses the objection to claims 1, 5, 8, 9, 16, 17, 24, 25, and 27. The M.P.E.P. in section 707.07(g) states "[p]iecemeal examination should be avoided as much as possible. The Examiner ordinarily should reject each claim on all valid grounds available." In this application, the Examiner has objected to the terms "presettable conditions," "presettable value," "presettable amount" and "settable period of time." Office Action p. 4. However, these terms have been present in the claims since the first Office Action in this application. Applicant submits that not only are these terms well defined and understood based on the disclosure of the specification, but also objecting to these terms at this point in prosecution is piecemeal examination.

The Office Action suggests an alternative for the term "presettable" in the claims is "preset" and for the term "settable" is "set." While Applicant is grateful for the Examiner's suggestion, Applicant respectfully submits that the terms "presettable" and "settable" are adequately defined in Applicant's specification. Applicant has claimed that, for example, "conditions" are "presettable" - able to be preset - not that the conditions are "preset." Applicant is entitled to "be his own lexicographer." M.P.E.P. § 2111.01(IV). Accordingly, the objection to these claim terms should be withdrawn at least because the terms are both defined and definite.

The Office Action further objects to claim 1 because "the method steps indicate that they are performed 'by a processor.' It is not clear to the Examiner whether they are performed by the same processor or different processors." Office Action p. 4. Applicant respectfully submits that whether or not the method steps are performed by "the same processor or different processors" does not render the claim unclear. The

Examiner is entitled to interpret the claim using the "broadest reasonable interpretation." However, the "broadest reasonable interpretation" (i.e., whether the "method steps" are "performed by the same or different processors) expressed by the Examiner does not render the claim unclear. It is merely a broader reading of the term "by a processor." Accordingly, since the term "by a processor" in claim 1 is neither unduly broad nor unclear, the objection to claim 1 should be withdrawn.

Applicant respectfully traverses the rejection of claims 1-5, 7-13, 15-21, 23-25, 27 and 28 under 35 U.S.C. ¶ 112, second paragraph.

The Examiner rejected claims 1, 5, 8, 9, 16, 17, 24, 25, and 27 because the terms "presettable" and "settable" are allegedly "vague and indefinite." For the reasons discussed above with respect to the objection of these claims, Applicant respectfully submits that the rejection of these claims should be withdrawn. Not only is this another example of piecemeal examination, but it is also improper because the terms "presettable" and "settable" are defined in the specification and the meanings of these terms are readily apparent to those of ordinary skill in the art.

The Office Action rejected claims 1, 9, 17, and 25 because the term "depending upon the manner or degree to which . . . [a] condition [is] satisfied" is allegedly unclear. Office Action p. 5. The Office Action alleges that "[m]anner and degree are not parameters in whether or not a condition is satisfied." *Id.* The Office Action has interpreted this term as "depending upon whether or not . . . [a] condition [is] satisfied." *Id.*

Applicant respectfully traverses this rejection of claims 1, 9, 17, and 25. The Examiner has assumed that the claimed "conditions" are binary conditions. That is, the Examiner assumes that the claimed "conditions" are conditions that are either satisfied or not satisfied. However, the claim recites "performing . . . one or more actions depending on the manner or degree . . . to which [a] condition [is] satisfied." While the claimed "manner or degree" to which a condition is satisfied may include, "whether or not" it is satisfied, as interpreted by the Examiner, there is no basis to limit Applicant's claims to solely "whether or not" a condition is satisfied, according to the interpretation of Applicant's claims articulated in the Office Action. For example, the Office Action states that "[m]anner and degree are not parameters in whether or not a condition is satisfied" (emphasis added). Office Action p. 5. However, Applicant has claimed the "manner or degree" to which a condition is satisfied and not "whether or not" the condition is satisfied. The claim is neither vague nor indefinite. The Office Action merely fails to consider that a condition may be partially satisfied without being completely satisfied. Therefore, the "manner and degree" to which a condition is satisfied is not indefinite. The rejection of these claims should be withdrawn and examination should be based on Applicant's claims, as written.

The Office Action alleges that "the specific condition in question" in claims 1, 9, 17, and 25 allegedly lacks antecedent basis. Office Action p. 6. Without agreeing to the propriety of the rejection, claims 1, 9, 17, and 25 have been amended. Accordingly, the rejection is moot and should be withdrawn.

Dependent claims 7, 8, 15, 16, 23, and 24 stand rejected because the term “the calculated impairment price” is allegedly indefinite. Specifically, the Office Action states that the claims “require that the impairment price is calculated in the claim upon which each depends. However, if the impairment price is not calculated in the claim upon which each depends[,] there is a lack of antecedent basis for ‘the impairment price.’” Office Action p. 6. However, this is not correct.

The claims do not “require that the impairment price is calculated,” as the Office Action suggests. Independent claim 1, for example, recites “displaying a calculated impairment price.” Thus, all that is “required” by claim 1 is that a “calculated impairment price” is “display[ed].” Claim 7 for example, further limits the “calculated impairment price” as a “market price for the object.” Claim 7 does not require that a “calculation” to have taken place in claim 1, it merely further identifies the “calculated impairment price” that is “display[ed].” Thus, the Office Action’s allegation that the dependent claims lack antecedent basis is incorrect because, contrary to the assertions of the Office Action, claim 1 does not “require that the impairment price is calculated.” See Office Action p. 6. Claim 1 recites a “calculated impairment price” that can be obtained from any other source using any other method at any time prior to its display.

Claim 25 is rejected because “[i]t is not clear to the Examiner what the difference is between the intermediate value and an intermediate value” (emphasis original). Office Action p. 7. Claim 25 has been amended to overcome the rejection.

Claim 25 is also rejected because the claimed “testing the intermediate variable” is allegedly “vague and indefinite.” Office Action p. 7. While claim 25 has been

amended to address the Examiner's concerns, the Examiner also alleges that "it is not clear in the second limitation whether the intermediate value is tested for satisfying a preset condition or an average intermediate value is tested for satisfying a preset condition" (emphasis original). *Id.* Applicant notes that the claim recites "testing the intermediate variable" includes "testing the disparity between the intermediate variable and an average value for the intermediate variable ascertained over a settable period of time, by a presettable amount." Thus, in accordance with the claims, the "intermediate variable" is tested. The "intermediate variable" is tested by the "disparity" between two values. The "disparity" is the disparity between the value of the "intermediate variable" and the "average value for the intermediate variable." The "average value for the intermediate variable" is ascertained over a "presettable period of time" and by a "presettable amount." Accordingly, claim 25 is definite. The rejection should be withdrawn.

Finally, claim 27 is rejected because the "concept of 'drawing attention' is vague." Claim 27 has been amended to overcome the rejection. Accordingly, Applicant respectfully requests that the rejection of claim 27 be withdrawn.

Dependent claims 2-5, 7, 8, 10-13, 15, 16, 18-21, 23, 24, 27, and 28 were rejected as being dependent on a rejected base claim. Inasmuch as each of the independent claims are definite, the dependent claims are definite. Accordingly, Applicant respectfully requests that the rejection of these claims be withdrawn.

Applicant respectfully traverses the rejections of the claims under 35 U.S.C. § 103(a). A *prima facie* case of obviousness has not been established with respect to

these claims, because the claims have been improperly construed and because the cited references do not teach or suggest each and every feature of the claims, as asserted by the Office Action.

The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. See M.P.E.P. § 2142, 8<sup>th</sup> Ed., Rev. 6 (Sept. 2007). Such an analysis should be made explicit and cannot be premised upon mere conclusory statements. See *id.* “A conclusion of obviousness requires that the reference(s) relied upon be enabling in that it put the public in possession of the claimed invention.” M.P.E.P. § 2154. Furthermore, “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art” at the time the invention was made. M.P.E.P. § 2143.01(III), internal citation omitted. Moreover, “[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” M.P.E.P. § 2141.02(I), internal citations omitted (emphasis in original).

“[T]he framework for the objective analysis for determining obviousness under 35 U.S.C. § 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art.” M.P.E.P. § 2141(II). “Office personnel must explain why the difference(s)

between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art." M.P.E.P. § 2141(III).

Claim 1 recites, in part, "displaying the manner or degree to which the conditions are satisfied." The Office Action correctly recognizes that Brown does not disclose or suggest at least this feature of claim 1. Office Action p. 9. The Office Action does allege, however, that Jones remedies the deficiencies of Brown. *Id.* But, this allegation is not correct.

Jones discloses:

At step 840, advice processing is performed. According to one embodiment of the present invention, based upon the user's preference among the decision variables, the system may offer advice regarding which decision variable should be modified to bring the portfolio back on track to reach the one or more financial goals with the desired probability. In addition, the system may recommend a reallocation to improve efficiency of the portfolio. An alert may be generated to notify the user of the advice and/or need for affirmative action on his/her part. As described above, the alert may be displayed during a subsequent user session with the financial advisory system 100 and/or the alerts may be transmitted immediately to the user by telephone, fax, email, pager, fax, or similar messaging system.

Jones col. 28, lines 24-37 (emphasis added).

The Office Action alleges that "offering advice and displaying an alert is indicative to Applicant's displaying advice regarding the balance sheet objects on a display." Office Action p. 3. However, even if Jones discloses "displaying advice," which Applicant does not concede, there is nothing in Jones that discloses or suggests displaying the "manner or degree to which the conditions are satisfied."

For example, Jones discloses displaying "advice" regarding a "decision variable [that] should be modified to bring the portfolio back on track." But, it is the "alert" itself that is "displayed during a subsequent user session." Jones does not disclose or



suggest that the either the "decision variable" or the "manner or degree" to which a "condition is satisfied" is displayed, as claimed. Accordingly, since Jones does not remedy the deficiencies of Brown, a *prima facie* case of obviousness has not been established. The rejection of claim 1 under 35 U.S.C. § 103(a) should be withdrawn.

Notwithstanding the above, claim 1 is allowable for at least another separate and distinct reason. Brown teaches away from Jones.

The Office Action states "[i]n response to applicant's arguments that there is no teaching, suggestion, or motivation to combine the references . . . the examiner recognizes that obviousness may be established by combining or modifying teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so." Office Action pp. 2-3. The Examiner alleges that in this application, "[e]ach reference is clearly related to valuating assets (securities)." However, the relation of each of the references to each other is irrelevant. M.P.E.P. § 2144 states that "rationale to modify or combine the prior art does not have to be expressly stated in the prior art; the rationale may be expressly or impliedly contained in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent established by prior case law." But, M.P.E.P. 2145 (X)(2) states "[i]t is improper to combine references where the references teach away from their combination." Thus, even if the references are related, it is irrelevant because the references do not work together for the same purpose. Brown is designed to lose money. See Brown paragraph [0014]. Jones is designed to optimize a portfolio to make money. See Jones col. 2, lines 33-52.

There can be no reason to combine a system that desires to lose money with another system that desires to make it. Furthermore, at the very least, even if such a reason does exist, it has not been articulated in the Office Action. Therefore, because Brown teaches away from Jones, a *prima facie* case of obviousness has not been established with respect to claim 1. The rejection should be withdrawn.

Independent claims 9, 17, and 25 contain features similar to those discussed in connection with claim 1. None of Fickes, Adhikari, or Kumar remedy any of the deficiencies of Brown and Jones as outlined above. Applicant therefore asserts that these claims are allowable for at least similar reasons as claim 1. The dependent claims are allowable for at least the same reasons as the independent claims from which these dependent claims depend. Applicant respectfully requests the Examiner withdraw the rejections of the claims under 35 U.S.C. § 103 and allow the claims.

**CONCLUSION**

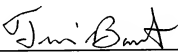
In view of the foregoing, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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